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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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*2*

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/468,889**

Applicant(s)  
**POUNDERS JR.**

Examiner  
**Kent L. Bell**

Art Unit  
**1661**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to ~~communication(s) filed on~~ application filed December 22, 1999
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 ~~is/are~~ pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 ~~is/are~~ rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s).
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

*K. L. Bell*

**Detailed Action**

**Status of Application**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

**Drawing Notification**

The submitted photographic illustrations have been objected to by an Official Draftsperson under 37 CFR 1.165(a) for the reason(s) set forth on the attached PTO-948. By way of explanation, the paper which the photographic illustrations is mounted is of insufficient weight (37 CFR 1.84(b)) and the top margin width is not the appropriate size (37 CFR 1.84(g)). The proper margin widths are : Top- 2.5 cm, Left- 2.5 cm, Right- 1.5 cm, and Bottom- 1.0cm. Applicant should submit photographic illustrations mounted on paper that complies with 37 CFR 1.84(b) with the proper margin widths that comply with 37 CFR 1.84(g). Upon submission of the new photographic illustrations, applicant should cancel the originally filed photographic illustrations.

**Title**

The title must relate to The Plant (MPEP 1610). The following title is suggested:

--ILEX HYBRID PLANT NAMED 'XIA YEN'--.

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**Claim**

The following claim is suggested:

--A new and distinct variety of *Ilex X attenuata* plant named 'Xia Yen', as illustrated and described.--.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Applicant should set forth in the specification the parental cultivars of the instant plant, if known, and if known which was the seed parent and which was the pollen parent.

B. If the parental cultivars are known, applicant is requested to set forth in the specification whether the parental cultivars and commercial cultivars 'Foster #2' 'Foster #3', 'East Palatka', 'Xia Xiang', and 'Huo Yen' have been patented in the United States, is currently

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the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate name.

C. If the parental cultivars are known, applicant should import into the specification a brief comparison between the instant cultivar and the parental cultivars, such need not be in any great detail, but should at least be to the extent to positively distinguish the respective plants from each other.

D. Page 2, line 21, Applicant should set forth in the specification the type of cutting used for asexually reproducing the instant cultivar. Also, an --s-- should be added to the word "cutting".

E. Page 2, line 24 and Abstract, Applicant's recitation that the instant plant will be marketed under the name 'DIXIE STAR HOLLY' is objected to as this is a presumptive rather than a factual statement. If the plant has been marketed as 'DIXIE STAR HOLLY' the specification should so state. If not, this recitation should be deleted as the specification is a

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factual recitation of plant characteristics, not a recitation of things which may or may not take place at all. Correction and/or clarification is necessary.

F. Page 2, lines 21-23, Applicant states "characteristics has been established and transmitted to successive generations". However, applicant has not stated that the characteristics are fixed and reproduced true to type. Applicant should delete "has been established" at line 23 and insert --are fixed, reproduces true to type--.

G. Page 3, line 2, Rather than stating "specimens" applicant should insert --plants-- as this recitation would be more appropriate in this instance.

H. Page 3, lines 6 and 7, Applicant states "FIG.". When compared to the photographic illustrations provided, applicant states "FIGURE". The specification and figure labels should correspond to each other. If "Fig" is stated in the specification then "Fig" should be stated on the photographic illustrations. The same holds true for "Figure". Correction is necessary.

I. Page 3, lines 9-11, Applicant should set forth in the specification the age of the plants when described.

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J. Applicant should set forth in the specification additional information relative to the instant plant's foliage such as the typical and observed apex and base descriptors in the interest of providing as complete a botanical description of the plant as is reasonably possible.

K. Page 3, line 21, Applicant states the petiole is from 7 to 9 mm. However, applicant does not specify whether the dimension set forth is for length or width. Correction and/or clarification is necessary.

L. Applicant should set forth in the specification the typical and observed stem length, width, and internode length.

M. Applicant should import into the specification information regarding the specific botanical features of the flower buds of the instant cultivar such as characteristic and observed length, diameter, shape, and coloration with reference to the employed color chart.

N. Page 4, lines 5-7, Applicant should set forth in the specification additional information relative to the instant plant's flowers including the typical and observed sepal shape, length, width, apex and margin descriptors, and coloration (both surfaces), petal shape, length, width, apex, base, and margin descriptors, and flower type, diameter, and fragrance (whether flowers have a



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fragrance or not, if they do what do they smell like) in the interest of providing as complete a botanical description of the plant as is reasonably possible. Color designation(s) should be referenced by the employed color chart.

O. Page 4, line 6, "pedals" should be deleted and --petals-- should be inserted in its place. Correction is necessary.

P. Page 4, line 6, Applicant sets forth a color designation for the petals. However, applicant has not specified whether the color designation set forth is for the upper, lower, or both surfaces. Applicant should set forth in the specification which surface(s) the color designation represents. If the color designation is for both surfaces, the specification should state such. If the color designation is for one surface, applicant should state which surface is being described and set forth the coloration of the opposite surface with reference to the employed color chart.

Q. Applicant should set forth in the specification information relative to the instant plant's reproductive organs including anthers, stigma, styles, ovary/ies, pistil number. (such as quantity, size and coloration of organs) into the specification with reference to the employed color chart. If pollen is produced, such should be accounted for in general terms relative to the quantity and in coloration by way of reference to the employed color chart.

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R. Applicant should set forth in the specification the typical and observed ultimate height and width, and trunk diameter, if available.

S. Page 4, lines 21 and 22, Applicant recites "It is anticipated". "It is anticipated" is prospective rather than factual as this recitation does not state something which has occurred. If this statement is now factual, it should be amended to reflect such. If the statement is not factual, applicant should set forth the typical and observed conditions which this cultivar has adapted.

T. Applicant should set forth meaningful information relative to the instant cultivar's observed and characteristic resistance or susceptibility to disease and pests, to the extent known.

U. Information relative to the instant plant's Winter hardiness should be imported into the specification.

V. Abstract, Applicant states "the new evergreen holly distinguished from all other forms of Ilex in that it combines a unique combination of desirable landscape and production traits from the parental species". Applicant should insert --known to me-- or similar after "Ilex" as it is in the realm of possibility that another cultivar may exhibit the traits of the parental species of the instant plant unknown to the inventor.

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The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Reference Cited**

United States Plant Patent 11,741 as cited but not applied in any rejection herein is made of record to show the state of the art, and is the most similar patented cultivar to the instant plant known to the Examiner.

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT L. BELL  
PATENT EXAMINER**

*Kent L. Bell*